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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/635,590	08/05/2003	Kenichi Hanamata	3864/0N107US0	1377
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DARBY & DARBY P.C. P. O. BOX 5257 NEW YORK, NY 10150-5257			MANCHO, RONNIE M	
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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/635,590	Applicant(s) HANAMATA, KENICHI	
	Examiner Ronnie Mancho	Art Unit 3663	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Remark (1)

1. Upon review of the pre-appeal brief submitted 2/27/06, it is deemed that a first office non-final action is necessary. Any inconvenience to the applicant is regretted.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1, 2, 4-6 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In amended claim 1, the applicant claims "said function checker outputting a predetermined control signal into said control unit when said function checker receives a predetermined signal from various vehicle information data". The applicant specifically refers the examiner to page 6, lines 12-26 of the specification. This limitation is not taught in the specification as applicant claims. Although part of the limitation "said function checker outputting a predetermined control signal into said control unit" is taught on the said page 6, the specification does not teach the time or when the predetermined control signal is outputted by

Art Unit: 3663

the function checker as claimed by the applicant. That is the limitation “when said function checker receives a predetermined signal from various vehicle information data” is not taught.

Claims 2, 4-6 are rejected for depending on rejected base claim 1.

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1, 2, 4-6, 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the applicant recites “a self-diagnosis function for self-diagnosing a verification of a reception of a signal concerning a switch”. On the other hand, the body of the claim makes no mention of how to diagnose “a verification of a reception of a signal concerning a switch”.

Claims 2, 4-6 are rejected for their dependence on rejected base claim 1.

In claim 7, “the plurality of switches” lacks antecedent basis. That is, the preamble of the claims reads “a control system of vehicle *for self-diagnosing a verification of a reception of signals from a plurality of switches*”, which refers to an intended use of the apparatus. The limitation, “*a plurality of switches*” is therefore not actively claimed. To overcome the 112 2nd rejection, claim 7 may be changed to a method claim or the limitation, “*for self-diagnosing*” may be written as --configured to self-diagnose--. The same modification applies to the other limitations, wherein “for verifying the” could be written as --configured to verify the--; “for transmitting a” could be written as -- configured to transmit a --; “activates the” could be written as --configured to activate the--, etc.

Remark (2)

6. In claim 1, the applicant recites “connecting means for connecting”. The 112 sixth paragraph was not properly invoked in the claims because there was too much recitation of structure that performs --the connecting -- in the means clause. The phrase, “connecting means for connecting” could be written as -- means for connecting-- to properly invoke the 112 6th paragraph. See MPEP 2181 (R-3), identifying a 35 USC 112, sixth paragraph.

Therefore, claims 1, 2, 4-6 will be interpreted as an apparatus claim.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 1, 2, 4-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Ishii et al (5553488).

Regarding claim 1, Ishii et al (figs. 2&3; cols. 5&6) disclose a control unit 51 for a vehicle having a self-diagnosis function for self-diagnosing a verification of a reception of a signal concerning a switch (col. 6, lines 61 to col. 7, lines 1-14) based on various vehicle information data, comprising:

connecting means 28 for connecting a function checker 27, said function checker 27 (fig. 2) outputting a predetermined control signal (CMF = [1] ?, box 102, fig. 3; col. 6, lines 40-51)

Art Unit: 3663

into said control unit 51 (col. 6, lines 20-51) when said function checker 27 receives a predetermined signal from the various vehicle information data (col. 5, lines 56-65),

wherein said predetermined control signal ($CMF = [1]$?; fig. 3; col. 6, lines 40-51) causes said control unit 51 to activate said self-diagnosis function to establish a self-diagnosis mode (col. 6, lines 20-60; col. 7, lines 4-10).

Regarding claim 2, Ishii et al disclose the control unit according to claim 1, wherein said control unit outputs a diagnosed result of the self-diagnosis mode as the vehicle information data to the function checker (col. 4, lines 45-61; col. 7, lines 15-20).

Regarding claim 4, Ishii et al disclose the control unit according to claim 2, wherein the function checker displays a diagnosed result of the self-diagnosis mode based on the received vehicle information data. (col. 4, lines 45-61; col. 7, lines 15-20).

Regarding claim 5, Ishii et al disclose the control unit according to claim 1, wherein said control unit outputs a diagnosed result of the self-diagnosis mode as an actuating control signal for controlling at least either one of a room lamp or an indicator lamp (col. 4, lines 45-61; col. 7, lines 15-20).

Regarding claim 6, Ishii et al disclose the control unit according to claim 2, wherein said control unit outputs a diagnosed result of the self-diagnosis mode as an actuating control signal for controlling at least either one of a room lamp or an indicator lamp (col. 4, lines 45-61; col. 7, lines 15-20).

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ishii et al (5553488) in view of Kato et al (4497057)

Regarding claim 7, Ishii et al (figs. 2&3; cols. 5&6) disclose a control system of vehicle for self-diagnosing a verification of a reception of signals from a plurality of switches (col. 2, lines 25-30; col. 6, lines 3-11), comprising:

a control unit 51 provided with a self-diagnosis function (fig. 3; col. 6, lines 20-67) for verifying the reception of the signals from said switches;

a function checker 27 connected with said control unit 51;

a first communication line (fig. 2) connecting said control unit 51 with a first switch 45 (figs. 1&2; col. 6, lines 1-19) to transmit a first signal issued from the first switch to said control unit 51;

a second communication line (figs. 1&2) connecting said control unit 51;

a third communication line (figs. 1&2) for said function checker 27 to catch the first signal from said first communication line; and

a fourth communication line (figs. 1&2);

wherein said control unit 51 activates the self-diagnosis function to establish a self-diagnosis mode.

Ishii et al disclose the limitations above, but did not particularly disclose a second switch connected to a control unit. However, Kato (abstract; figs. 1&3; col. 3, lines 31-67) disclose a control system of vehicle for self-diagnosing a verification of a reception of signals from a plurality of switches comprising:

a second communication line (figs. 1&3; col. 3, lines 31-67) connecting said control unit 6 with a second switch to transmit a second signal issued from the second switch to said control unit 51;

a third communication line (figs. 1&3; col. 3, lines 31-67) for said function checker 7 (col. 6, lines 4-19) to catch the first signal from said first communication line; and

a fourth communication line (figs. 1&3; col. 3, lines 31-67) for transmitting a pseudo signal of the second signal from said function checker to said control unit through said second communication line when said function checker receives the first signal,

wherein said control unit 6 activates the self-diagnosis function to establish a self-diagnosis mode when receiving the pseudo signal of the second signal so that the reception of signals from the plurality of switches can be verified (figs. 1&3; col. 3, lines 31-67).

Therefore, it would have been obvious to one of ordinary skill in the art of vehicle diagnosis to modify Ishii as taught by Kato for the purpose of providing a diagnostic system a plurality of control system are adapted to execute control separately and to selectively display malfunction display signals (col. 3, lines 1-9).

Regarding claim 8, Ishii et al disclose the control system according to claim 7, wherein said control unit outputs a diagnosed result of the self-diagnosis mode as an actuating control

Art Unit: 3663

signal for controlling at least either one of a room lamp or an indicator lamp (col. 4, lines 45-61; col. 7, lines 15-20).

Regarding claim 9, Ishii et al disclose the control system according to claim 7, wherein said first switch is the ignition switch (col. 2, lines 25-30; col. 6, lines 3-11),.

Regarding claim 10, Ishii in view of Kato et al disclose the control system according to claim 7, wherein said second switch is a door switch 2f (Kato et al; figs. 1&3; col. 3, lines 31-67), which needs no verification of a reception of a signal thereof.

MPEP 2114

11. The statement of intended use or field of use, "for a vehicle", "for self-diagnosing", "based on", "for connecting", "outputting a", "when said....receives", "to activate", "to establish", "outputs a", "displays a", "for controlling", "for verifying", "for transmitting", "activates the", "when receiving the", etc clauses are essentially method limitation or statement of intended or desired use. Thus, the claim as well as other statements of intended use do not serve to patentably distinguish the claimed structure over that of the reference. See *In re Pearson*, 181 USPQ 641; *In re Yanush*, 177 USPQ 705; *In re Finsterwalder*, 168 USPQ 530; *In re Casey*, 512 USPQ 235; *In re Otto*, 136 USPQ 458; *Ex parte Masham*, 2 USPQ 2nd 1647. See MPEP § 2114 which states:

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from the prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. *Ex parte Masham*, 2 USPQ 2nd 1647.

Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than functions. In re Danly, 120 USPQ 528, 531.

Apparatus claims cover what a device is not what a device does. Hewlett-Packard Co. v. Bausch & Lomb Inc., 15 USPQ2d 1525, 1528.

As set forth in MPEP § 2115, a recitation in a claim to the material or article worked upon does not serve to limit an apparatus claim.

Response to Arguments

12. Applicant's arguments filed 2/27/06 have been fully considered but they are not persuasive.

The applicant contends that claim 1 has been amended, but the record shows no amendment. Applicant is advised to follow the guidelines when amending claims e.g. to underline the amendment, indicate in brackets that the claim has been amended, etc.

The applicant is arguing that the prior art does not disclose “that the external diagnosing unit 27 receives any signal from the any vehicle information data before the self diagnosis mode changes to the check mode”. In response, no such limitation is disclosed in the claims such as “*before the self diagnosis mode changes to the check mode*”. Even if such a limitation was in the claims, the limitation would be a method limitation in a n apparatus claim according to MPEP 2114. The applicant is making an argument citing different limitations that are not exactly related to the limitations in the claims.

The applicant further argues that the prior art does not disclose “....., which *in response to receiving* a predetermined control signal,*which cause* the control system to

Art Unit: 3663

activate". These limitations including others are method limitations in an apparatus claim and do not serve to patentably distinguish the invention from the prior art. A few more of the method limitations, of which all are not listed in this response" are "when the self-diagnosing mode changes to", "when the function checker receives", etc. These are all examples of intended uses of the apparatus and do not structurally distinguish the apparatus from the prior art. Even if the prior art does not disclose the exact language as found in applicant's claims, the prior art is capable of performing such actions. The prior art disclose all the structural features of the claims. .

The arguments pertaining to claims 7-10 are moot in view of newly found prior art.

The examiner still maintains that during the interview conducted with applicant's representative, the applicant's representative agreed to amend the claims to overcome the 112 and other issues pertaining to the new matter rejection.

In the advisory action, the examiner implied that if the claims were amended to overcome the new matter issues, the 112 will be withdrawn upon filing an RCE since the applicant's representative had agreed that changes will be made to correct the 112 and 102 (b) issues. Applicant did not proceed with the claims as agreed during the interview. It seems as applicant did not understand the examiner's position in the advisory. However, with the current explanation, it is believed that the issues in the advisory are clear.

The applicant further states that the prior art does not disclose "said function checker outputting a predetermined control signal into said control unit when said function checker receives a predetermined signal from various vehicle information data". The applicant specifically refers the examiner to page 6, lines 12-26 of the specification. This limitation is not

Art Unit: 3663

taught in the specification as applicant claims. Although part of the limitation “said function checker outputting a predetermined control signal into said control unit” is taught on the said page 6, the specification does not teach the time or when the predetermined control signal is *outputted* by the function checker as claimed by the applicant. That is the limitation “when said function checker receives a predetermined signal from various vehicle information data” is not taught. These are all examples of intended uses of the apparatus and do not structurally distinguish the apparatus from the prior art. Even if the prior art does not disclose the exact language as found in applicant’s claims, the prior art is capable of performing such actions.

Further, the applicant cites that the prior art “does not disclose that the control unit activates the self-diagnostic function”. In response the examiner disagrees. The prior art columns 5&6 and the drawings disclose the limitation even the exact words were not used. That is, switching from one mode of operation to another mode of operation constitutes activating said other mode of operation..

It is believed that the rejections are proper and thus stand.

Communication

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ronnie Mancho whose telephone number is 571/272/6984. The examiner can normally be reached on Mon-Thurs: 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner’s supervisor, Jack Keith can be reached on 571-272-6878. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Art Unit: 3663

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Ronnie Mancho
Examiner
Art Unit 3663

7/6/06

A handwritten signature in black ink, appearing to read "Ronnie Mancho". The signature is written in a cursive, flowing style with a large initial "R" and a long, sweeping underline.